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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,685	03/09/2000	David P. Maher	112770	1985
26652	7590	03/07/2005	EXAMINER	
AT&T CORP. P.O. BOX 4110 MIDDLETOWN, NJ 07748			HAYES, JOHN W	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/521,685

Applicant(s)

MAHER, DAVID P.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-53 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-53 and 57-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Final Rejection Withdrawn

1. Applicant's remarks in the after final amendment filed 31 January 2005 are persuasive and, therefore, the final rejection mailed 08 September 2004 is hereby withdrawn. Prosecution is hereby reopened and a new non-final rejection follows below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 44-47, 49, 57 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al, U.S. Patent Application Publication No. US 2002/0069174 A1 in view of Fox et al, U.S. Patent No. 5,790,677.

As per **Claim 44**, Fox et al ('174) disclose a method performed by a guarantor of payment for purchases comprising:

- receiving from a user a request to send to the user at least one short-term certificate, the request containing at least information that verifies the identity of the user (0009; 0073-0074; 0078; 0136; 0138);
- responsive to the request, and upon authenticating the user, determining a maximum amount during which said guarantor is willing to provide payment for purchases by the user (0009, 0014);
- sending to the user a short term certificate guaranteeing payment up to said maximum amount for a purchase by the user from a supplier in a transaction carried out over a network, so that use user is enabled to enter into a transaction using the short term certificate as a form of payment that will be accepted by the supplier (0009; 0016; 0079; 0139);

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- receiving the short-term certificate from the supplier (0009; 0142; 0144);
- making payment to the supplier for the purchase a) without having received from the supplier any request for assurance relative to the short-term certificate or relative to the guarantor's guarantee to make the payment, and b) without providing any such assurance to the supplier (0009; 0142; 0144).

Although it is generally well known to include expiration information or validity periods in certificates, Fox et al ('174), however, fail to disclose this. Fox et al ('174) further fail to disclose receiving an electronic record of the transaction from the supplier. Fox et al ('677) disclose generating and sending credentials to consumers to be used during a transaction (Col. 11, lines 14-25; Col. 23, lines 10-55). Fox et al ('677) further disclose that the credential includes expiration information or a validity period (Col. 11, lines 15-23; Col. 23, lines 25-35 and 40-48). Fox et al ('677) further disclose that the purchaser creates a commerce document such as a purchase order (Col. 12, lines 50-57) and a commerce instrument such as a purchase instruction identifying a method of payment (Col. 25, lines 3-13) including the purchaser's credential and forwards this to the supplier in order to initiate a transaction. The supplier then forwards the purchase instruction (electronic record of the transaction) to the acquirer server in order to receive payment (Col. 25, lines 44-50). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the method of Fox et al ('174) and include in the short term certificate expiration information or a validity period as taught by Fox et al ('677) in order to limit the timeframe in which the certificate is valid as is well known in the use of digital certificates. It also would have been obvious to modify the method of Fox et al ('174) and include sending an electronic record of the transaction to the guarantor so that the guarantor has a record of the transaction when paying the merchant.

As per Claims 45-46, Fox et al ('174) fail to explicitly disclose billing the user for the purchase through a regular billing channel between the guarantor and the user, however, this is disclosed by Fox et al ('677) (Col. 26, lines 13-22). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the method of Fox et al ('174) and provide for a method for ultimately billing the purchaser for the goods purchased as taught by Fox et al ('677). This would have

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been a typical step carried out in any transaction in order to complete the transaction and bill the user for the goods purchased through conventional channels.

As per Claim 47, Fox et al ('174) further disclose wherein the short term certificate further includes an assertion of at least one entitlement of the user in addition to the ability to use the short term certificate to pay for purchases (0009; 0014; 0017; 0166).

As per Claim 49, Asay et al further disclose wherein the short term certificate further includes an indication that the user is entitled to use a form of payment other than money such as a letter of credit (0017).

As per Claims 57 and 60, Fox et al ('174) disclose a method performed by a supplier of goods or services comprising:

- receiving short-term certificate from a customer that contains a maximum amount during which the guarantor is willing to guarantee payment for purchases by the customer (0009; 0016; 0089-0091; 0142-0144);
- consummating a purchase transaction with the customer over a network including acceptance of the short term certificate as payment for the purchase without seeking any assurances relative to the short term certificate or relative to the guarantor's guarantee to make the payment, other than any assurances contained in the short term certificate itself, (0009; 0016; 0089-0091; 0142-0144);
- sending the short-term certificate to a billing system for payment from guarantor (0009; 0142; 0144);
- receiving the payment from the guarantor (0009; 0144).

Although it is generally well known to include expiration information or validity periods in certificates, Fox et al ('174), however, fail to disclose this. Fox et al ('174) further fail to disclose receiving an electronic record of the transaction from the supplier. Fox et al ('677) disclose generating and sending credentials to consumers to be used during a transaction (Col. 11, lines 14-25; Col. 23, lines 10-55). Fox et al ('677) further disclose that the credential includes expiration information or a validity period

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(Col. 11, lines 15-23; Col. 23, lines 25-35 and 40-48). Fox et al ('677) further disclose that the purchaser creates a commerce document such as a purchase order (Col. 12, lines 50-57) and a commerce instrument such as a purchase instruction identifying a method of payment (Col. 25, lines 3-13) including the purchaser's credential and forwards this to the supplier in order to initiate a transaction. The supplier then forwards the purchase instruction (electronic record of the transaction) to the acquirer server in order to receive payment (Col. 25, lines 44-50). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the method of Fox et al ('174) and include in the short term certificate expiration information or a validity period as taught by Fox et al ('677) in order to limit the timeframe in which the certificate is valid as is well known in the use of digital certificates. It also would have been obvious to modify the method of Fox et al ('174) and include sending an electronic record of the transaction to the guarantor so that the guarantor has a record of the transaction when paying the merchant.

4. Claims 48, 50-53 and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al, U.S. Patent Application Publication No. Us 2002/0069174 A1 and Fox et al, U.S. Patent No. 5,790,677 as applied above and further in view of Golden et al, U.S. Patent No. 5,761,648.

As per Claims 48, 50-53 and 58-59, Fox et al ('174) fail to explicitly disclose wherein the short term certificate contains information specifying consumer points, consumer marketing offers or purchase discounts. Golden et al disclose an interactive marketing network and process using electronic certificates and teach issuing electronic certificates to users that can be used for various purposes and include specifying coupons, discounted prices on a product or service, proof of a gift or award such as loyalty points, proof of payment or any other type of certificate or voucher (abstract, Col. 8, lines 10-18). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fox et al ('174) and Fox et al ('677) and allow for the specification of certain points, marketing offers or discounts in the certificate as taught by Golden et al. Golden et al provides motivation for providing these discounts in a certificate by indicating that this provides added efficiencies to companies merchandising products and services online (Col. 1, lines 10-63). Fox et al ('174) provides

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further motivation by indicating that the certificate may be used for shopping clubs wherein a member may purchase goods at the club (0166).

Conclusion

5. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

6. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Sudia discloses a method for securely using digital signatures in a commercial cryptographic system and further teach a user long term basic certificate as well as a short term authorization certificate that specifies transaction amount limitations and time limits.
- Fox et al [US 2002/0069174] disclose a system for electronic commerce transactions and further teach sending a customer certificate to a bank for payment
- Walker et al disclose a method for executing cryptographically enabled letters of credit

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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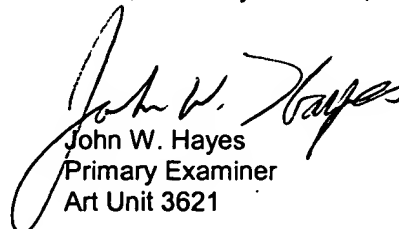
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

March 7, 2005